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Attorney Docket: 443-17

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPLICANT: Masaaki Yamanaka et al. **EXAMINER:** Kruer, Kevin R.

SERIAL NO.: 08/855,905 **GROUP ART UNIT:** 1773

FILED: May 14, 1997 **DATED:** May 25, 2005

FOR: SYNTHETIC PAPER MADE OF
STRETCHED POLYPROPYLENE FILM

MAIL STOP APPEAL BRIEF-PATENTS
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

Pursuant to 37 C.F.R. §41.41, please enter and consider the following Reply Brief the Examiner's Answer mailed March 25, 2005 by the Patent and Trademark Office in the above-identified application. Reference will be made to the various passages in the Examiner's Answer. The following points I-VI will be explicitly addressed:

I. Applicants' Arguments Concerning the Rejections Raised in the Office Actions

Mailed November 2, 1998 and May 20, 1999 Are Not Moot

In the second full paragraph on page 9 of the Examiner's Answer, it is stated:

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postpaid in an envelope addressed to Mail Stop APPEAL BRIEF-PATENTS, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: May 25, 2005

George M. Kaplan

Appellant's initial comments with regard to the position that it would have been obvious to use the antistatic compound of Ueda [et al] in the paper of Takashi [et al] are drawn to the Office Actions mailed November 2, 1998 and May 20, 1999. The examiner notes that the grounds of rejection have been modified since said Office Actions. Therefore, Appellants' arguments with regard to said Office Actions are considered moot.

However, on the preceding pages 4-6 of his Answer, the Examiner makes the assertion it would have been obvious to utilize the polyetheresteramide of Ueda et al in the paper of Takashi et al, a direct contradiction to the assertion on page 9 of his Answer *supra*. For example, in the last full paragraph on page 4 of his Answer, the Examiner explicitly states:

Takashi [et al] teaches the use of an anti-static agent in a synthetic paper polypropylene composition, but does not teach the claimed antistatic composition. However, Ueda [et al] teaches an antistatic which may be utilized in a polypropylene composition. . . [emphasis added]

The following paragraphs through the third line on page 6 of his Answer contain arguments raised by the Examiner why it would be allegedly obvious to incorporate the antistatic agent of Ueda et al in the paper of Takashi et al. Accordingly, the arguments raised by Appellants throughout the prosecution of the present application are not at all moot.

II. The Claimed Invention Includes a Three-Layered Paper

In the Examiner's attack on the Second Supplemental Declaration of Masaaki Yamanaka, the Examiner asserts in the first full paragraph on page 15 of his Answer this Declaration fails to agree in scope with the present claims, because the claims do not require a three-layered paper. However, attending is respectfully called to pending Claim 47 which explicitly recites a three-layered paper.

III. Takashi et al *Fail* to Teach the Specific Stretching Amount of the *Claimed Composition*

In the first full paragraph on page 17 of his Answer, the Examiner asserts Takashi teaches uni-axially orienting the film disclosed in Takashi, but not the film recited in Claim 30 of the present application. Accordingly, as stated under subheading 7(J) of Appellants' Brief, Takashi fails to disclose the specific stretching amounts of the specific paper recited in Claim 30.

IV. Creation of Voids Taught in Takashi et al Does Not Read on the Claimed Ultrafine Cracks

In the third full paragraph on page 17 of his Answer, the Examiner asserts Takashi et al teach creation of voids on the surface of the film which read on the claimed cracks. At column 6, lines 51-53, Takashi et al state the use of filler in the base material develops microvoids on the surface thereof which improves adhesion of the paper-like layers thereto. Thus, creation of microvoids on the surface of the base material in Takashi et al which is ultimately laminated to outer layers, clearly does not read upon the claimed ultrafine cracks formed, e.g., on the top (or bottom) surface of the stretched film by both stretching and oxidation and through which antistatic agent can penetrate. While column 5, lines 34-37 of Takashi et al refers to microvoids 52 on the surface of the paper-like film layers 3,5, these microvoids 52 are not denoted upon the figures in Takashi et al.

V. Takashi et al Fail to Disclose the Specific Corona Discharge Level in Claim 33

Claim 33 recites the corona discharge treatment is performed in an amount from 20 to 500 W/min•m². The Examiner has presented no evidence whatsoever to support his contention in the fourth full paragraph on page 17 of his Answer, that column 4, lines 41-51 of Takashi et al discloses the same discharge levels. If anything, it would appear the surface

layer voltage of 3,000 to 30,000 volts and plate current of 0.5 to 5 amperes, found at column 4, 47-49 of Takashi et al, are not the same as the range of corona discharge treatment recited in Claim 33.

VI. The Stretching into Long Particles is *Neither Explicitly Nor Inherently Shown in the Prior Art*

In the last full paragraph on page 18 of his Answer, the Examiner alleges “prior art” teaches orientation of particles when two resins having different melting points are mixed and then “oriented,” i.e., stretched. However, the Examiner fails to cite any prior art backing up this allegation. In this regard, inherency must be absolutely certain and not a mere possibility. *In re Oelrich* (CCPA 1981) 666 F.2d 578, 212 USPQ 323; *Ex parte Keith et al* (POBA 1966) 154 USPQ 320. The fact the Examiner has failed to cite any prior art backing up his contention, clearly constitutes evidence of improper hindsight reconstruction of the claimed invention in light of the invention disclosure found in the present application.

Respectfully submitted,



George M. Kaplan
Reg. No.: 28,375
Attorney for Applicant(s)

DILWORTH & BARRESE, LLP
333 Earle Ovington Blvd.
Uniondale, New York 11553
516-228-8484